

REMARKS

Claims 25 to 28 are added, and therefore claims 13 to 28 are now pending and being considered.

It is respectfully submitted that all of the presently pending and considered claims are allowable, and reconsideration is respectfully requested.

As to the requirement for information under 37 C.F.R. 1.98(a)(2), copies of the references need not be included since they are provided by the International Searching. The Search Report includes a list of documents that were considered by the Examiner in the underlying PCT application. Nevertheless, to facilitate matters, copies of the foreign references (cited and disclosed in the previously filed IDS and 1449 papers) accompany this response. It is respectfully requested that they be considered and made of record.

Claims 13 to 17, 19 to 21, 23, and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,138,788, (the “Bohner” reference) in view of U.S. Application No. 2003/0098197 (the “Laurent” reference). Further, Claims 6 and 7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the “Choi” reference.

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must

teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 13 recites, in relevant part, “providing an electromechanical coupling unit having at least two coupling windings, wherein the coupling unit is configured to provide selective coupling between the first and second mechanical devices, and wherein each of the coupling windings is configured to be supplied with electrical energy by at least one connected electrical control unit.” The “Bohner” reference does not disclose nor suggest the claim feature of “*having at least two coupling windings*, wherein the coupling unit is configured to provide selective coupling between the first and second mechanical devices.” The Office Action acknowledges this critical deficiency but relies on the “Laurent” reference to cure this defect. The Office Action asserts that “it would have been obvious to [a] person having ordinary skill in the art at the time of the invention to modify Bohner as taught by Laurent in order to provide a redundant check on the electrical system to ensure that it has failed before switching to the mechanical connection.” (Office Action, page 3).

However, prior art references must be considered as a whole, including portions that teach away from the claimed subject matter. *W.L. Gore, supra*. Furthermore, *prima facie* obviousness cannot be established based on a modification of a reference that destroys the intent, purpose, or function of the invention disclosed in the reference, since there is no suggestion or motivation to make the proposed modification. *See In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

The “Bohner” reference is directed to a “steer by wire” system” where in emergency situations, “*forced coupling is established* between the manual steering wheel 9 and the steered vehicle wheels 1.” (The “Bohner” reference, column 5, lines 24 to 35, (emphasis added)). The Office Action has interpreted this coupling to be between “two mechanical devices.” (Office Action, page 2). In stark contrast, the “Laurent” reference “relates to an electrical steering system without any mechanical linkage between the steerable wheels and the steering wheel.” (The “Laurent” reference, paragraph 0002, (emphasis added)). Instead of relying on a *mechanical coupling* as a backup, the “Laurent” reference employs “*triplication of certain components*, namely the position sensors, the electric motors, and the necessary controllers, as well as the electrical lines connecting the various components in question.” (*Id.*, paragraph 0009, (emphasis added)).

Thus, redundancy is used *instead* of a mechanical backup system, thereby teaching away from the “Bohner” reference. Furthermore, combining the two references would

destroy the intent, purpose, and function of the “Laurent” reference. Employing the redundancy scheme of the “Laurent” reference, would negate the need for a mechanical backup system of the “Bohner” reference. Therefore, one with ordinary skill in the relevant art would not be motivated to combine the references as suggested in the Office Action.

It is therefore respectfully submitted that claim 13 is allowable, as are its dependent claims. Claim 20 includes features like those of claim 13 and is therefore allowable for essentially the same reasons, as are its dependent claims.

Claims 18 and 22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the “Bohner” reference in view of the “Laurent” reference, and further in view of U.S. Patent No. 6,220,385 (The “Bohner II” reference).

Claims 18 and 22 respectively depend from claims 13 and 20 and are therefore allowable for at least the same reasons as their respective base claims, since the “Bohner II” reference does not cure -- and is not asserted to cure -- the critical deficiencies of claims 13 and 20. It is therefore respectfully submitted that claims 18 and 22 are allowable. It is therefore respectfully requested that the obviousness rejections be withdrawn.

New claims 25 to 28 do not add any new matter and are supported by the present application. Claims 25 to 27 depend from claim 20 and are therefore allowable for the same reasons. Claim 28 depends from claim 13 and is therefore allowable for the same reasons.

Accordingly, claims 13 to 28 are allowable.

Conclusion

In view of the foregoing, it is respectfully submitted that all of the pending claims are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

Respectfully submitted,

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